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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,065	10/06/2000	Mamoun Abu-Samaha	10005265-1	2855

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EXAMINER

LERNER, MARTIN

ART UNIT	PAPER NUMBER
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2626

DATE MAILED: 04/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/684,065	Applicant(s) ABU-SAMAHA, MAMOUN	
	Examiner Martin Lerner	Art Unit 2626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 21, 23 to 30, and 32 to 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 21, 23 to 30, and 32 to 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 to 21, 23 to 30, and 32 to 40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention.

Independent claims 1 and 11, as amended, contain limitations of “wherein the access module additionally is configured to create a replacement reference identifying a data item identified by a messaging/collaboration server reference into the messaging/collaboration data, pass the replacement reference to the voice device without passing the data item, and store an association between the replacement reference and the messaging/collaboration server reference”, which limitations are new matter.

Applicant states that support for the amendments to independent claims 1 and 11 are found on Page 16, Line 15 through Page 18, Line 34 of the Specification. However, Applicant's Specification, as originally filed, was reviewed, but neither express nor

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implied disclosure of limitations directed to a replacement reference identifying data, passing the replacement reference without passing the data item, and storing an association between the replacement reference and a messaging/collaboration server reference, was found. The passage cited by Applicant does state that access module 120 manages sessions by creating XML structures for holding long variable names and references, and by passing only simple references (e.g. an HTTP cookie) to the destination device. The passage also discloses that access module 120 stores on the server a sessionID_Inbox.xml file, which contains references to the actual content of each of the corresponding sub-messages.

Still, given the disclosure of the cited passage, Applicant has not provided support for the claimed limitations, as these claimed limitations go beyond what one having ordinary skill in the art could reasonably read from the cited passage. Applicant's originally-filed Specification does not set forth elements of "a replacement reference", "a messaging/collaboration server reference", or "messaging/collaboration data". Nor could one having ordinary skill in the art deduce the scope of "a replacement reference" as being commensurate with any or all of an XML structure, or an HTTP cookie, or a sessionID_Inbox.xml file. Similarly, one having ordinary skill in the art could not deduce that the scope of "a messaging/collaboration server reference" is commensurate with any or all of an XML structure, or an HTTP cookie, or a sessionID_Inbox.xml file. Applicant's Specification does not define the terms set forth by the claims, and one having ordinary skill in the art could not readily recognize that the scope of the claimed elements is contained within the originally-filed Specification.

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The scope of the terms recited in the claims cannot easily be translated into the elements disclosed by the Specification. Thus, Applicant's Specification does not define the terms of the claims with sufficient specificity as to inform one having ordinary skill in the art that Applicant had possession of the invention as now claimed at the time of filing.

Response to Arguments

Applicant's arguments filed 28 February 2006 have been fully considered but they are not persuasive.

Firstly, Applicant argues that the application need only convey to one skilled in the art that the inventor, at the time the application was filed, had possession of the claimed subject to satisfy the requirement of 35 U.S.C. §112, 1st ¶. Specifically, Applicant points to Page 18, Line 7 to 8, of the Specification, and states that at the time the application was filed, it was well-known to persons skilled in the art that the Microsoft Exchange Server uses unique, global pseudo-random 128-bit GUID (Globally Unique Identifier) numbers to identify items maintained in its messaging/collaboration folders (e.g., contacts, calendar, e-mail and task folders). Applicant cites Page 18, Lines 10 to 34 of the Specification, and states that it was well-known to such persons that an application could retrieve an item for a Microsoft Exchange Server folder by sending the server the GUID for the folder and the GUID for the item. Then, Applicant goes on to say that the 128-bit numbers following the brackets ">" in the ID="[number]" statement in the sessionID_Inbox.xml are messaging/collaboration server references

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because these numbers correspond to GUID numbers that are used by Microsoft Exchange Server to identify messaging/collaboration items (i.e. messages) in the "Inbox" folder, and that a person skilled in the art would have recognized that the numbers "1", "2", "3", "4", and "5", which are preceded by the "ID=" statements in the sessionID_Inbox.xml file, are replacement references for the messaging/collaboration server references because these statements tell an XML parser to replace the respective ID type values (i.e., "1", "2", "3", "4", and "5") with the associated messaging/collaboration server references. This position is traversed.

It is respectfully submitted that the claimed subject matter, as amended, is not disclosed by the originally filed Specification so as to comply with 35 U.S.C. §112, 1st ¶. Applicant's explanation of the invention is fairly clear in the Remarks. What is not clear on this point is Applicant's originally-filed Specification. Applicant's description here of what is disclosed by the originally filed Specification would be new matter if added to the Specification. Applicant's originally filed Specification must either disclose the newly claimed subject matter expressly, or inherently. Here, the Specification clearly does not disclose the newly claimed subject matter expressly. Moreover, it is maintained that one having ordinary skill in the art would not necessarily know the facts about Microsoft Exchange Server, which Applicant is contending makes the newly claimed invention inherent. Specifically, one skilled in the art of interactive voice response (IVR) systems could very well look at Applicant's Specification, Pages 16 to 18, and merely see dense and complex computer code that is not readily understood. It is contended that one may well need to be an expert in a computer language relating to the coding of

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Microsoft Exchange Server to deduce what Applicant is asserting as inherent from Pages 16 to 18 of the Specification. The "ID=" statements are not defined by Applicant's Specification as being "replacement references" for a global pseudo-random number (Global Unique IDentifier), nor is a global pseudo-random number (GUID) identified as a "messaging/collaboration server reference". To identify the claimed elements from lines of computer code would go beyond what is necessarily known by those skilled in the art.

One way to look at the issue of whether the newly claimed subject matter is disclosed by the originally filed Specification is to ask if Applicant's newly filed claims would reasonably be anticipated by Applicant's own originally filed Specification, if cited as a reference. Here, it is maintained that it may not be reasonable to reject claims directed to replacement references and messaging/collaboration server references based upon lines of computer code and the brief disclosures of Pages 16 to 18 of Applicant's Specification.

Secondly, Applicant cites Page 16, Lines 16 to 19, of the Specification, as stating that sessions are managed by creating XML structures for holding long variable names and references, and by passing only simple references (e.g., an HTTP cookie) to the destination device, and that when the destination device needs particular data, the simple reference may be replaced on the server with the actual referenced data, which may be passed to the messaging/collaboration server. Also, Applicant cites Page 18, Lines 7 to 8 of the Specification, as stating that an access module stores on the server the sessionID_Inbox.xml file, which contains references to the actual content of the

corresponding sub-messages. Thus, Applicant concludes that one skilled in the art would have understood that the access module passes replacement references to the destination device without passing the actual referenced data.

However, it is still maintained that Applicant's originally filed Specification does not disclose the newly claimed limitations of "wherein the access module additionally is configured to create a replacement reference identifying a data item identified by a messaging/collaboration server reference into the messaging/collaboration data, pass the replacement reference to the voice device without passing the data item, and store an association between the replacement reference and the messaging/collaboration server reference." Admittedly, there is some disclosure that a simple reference may be replaced on the server with the actual referenced data, and that references to the actual content of messages are stored on the server. However, Applicants claimed limitations of creating a replacement reference identifying a data item, passing the replacement reference to a voice device without passing the data item, and storing an association between the replacement reference and a messaging/collaboration server reference are, at least, not disclosed by the originally filed Specification, either expressly or inherently.

Therefore, the rejection of claims 1 to 21, 23 to 30, and 32 to 40 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement by containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention, is proper.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin Lerner whose telephone number is (571) 272-7608. The examiner can normally be reached on 8:30 AM to 6:00 PM Monday to Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Hudspeth can be reached on (571) 272-7843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ML
4/12/06



Martin Lerner
Examiner
Group Art Unit 2626